REMARKS

By this Amendment, Applicant amends claims 17, 20, 23, and 26. Upon entry of this Amendment, claims 21, 23-26, and 28 remain pending.

In the Final Office Action[1], the Examiner rejected claims 17-18, 20-21, 23-24, and 26-27 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-12 of Rader (U.S. Patent No. 6,370,581) ("*Rader*"); and rejected claims 17-18, 20-21, 23-24, and 26-27 under 35 U.S.C. § 103(a) as being unpatentable over Yergeau et al. "Internalization of the Hypertext Markup Language" ("*Yergeau*") in view of Berners-Lee et al. "Hypertext Transfer Protocol -- HTTP/1.0" ("*Berners-Lee*").

In response to the Final Office Action mailed March 24, 2006, Applicant filed a Terminal Disclaimer and a Request for Reconsideration on May 24, 2006. In response to the Request for Reconsideration, the Examiner issued an Advisory Action, mailed on June 20, 2006, recording and accepting the Terminal Disclaimer and stating that the request for reconsideration does not place the application in condition for allowance. The Examiner stated that "the current claims do not specify the 'actual length' of the multibyte message is the number of characters in the message" (emphasis added) (Advisory Action at page 2). The Examiner further asserted that "[i]t is apparent that an actual length of the message in the example given by Applicant is 10 bytes, which is the number given by Berners-Lee." Id.

[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

I. Regarding the rejection of claims 17-18, 20-21, 23-24, and 26-27 under 35 U.S.C. § 103(a) as being unpatentable over *Yergeau* in view of *Berners-Lee*

Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 17-18, 20-21, 23-24, and 26-27 because a *prima facie* case of obviousness has not been established with respect to these claims.

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither *Yergeau* nor *Berners-Lee*, taken alone or in combination, teach or suggest each and every element recited by Applicant's claims.

Claim 17 recites a method including, for example:

> storing . . .
> converting the fixed-byte format message into a multibyte format message including characters represented by various numbers of bytes, depending on the character;
> <u>obtaining an actual length in characters of the multibyte format message</u>;
> <u>packaging the information reflecting the actual length in characters of the multibyte format message with the multibyte format message</u>; and
> transmitting . . .

(emphasis added). *Yergeau* does not teach or suggest at least these elements. *Yergeau* discloses the transmission of HTML text in UCS-2 or UCS-4 form (page 19, paragraph 2). *Yergeau* states that UTF-7 and UTF-8 "have favorable properties . . . that

make them worthy of consideration, especially for transmission of multilingual text (page 19, paragraph 3). *Yergeau* merely states that such data transmission may be possible, but does not explicitly teach transmission using either UTF-7 and UTF-8 in their embodiments. Therefore, *Yergeau* does not teach "converting the fixed-byte format message into a multibyte format message including characters represented by various numbers of bytes, depending on the character," as recited in claim 17.

Even assuming, absent any teaching in *Yergeau*, that UTF-8 form can be used, *Yergeau* does not teach "obtaining an actual length in characters of the multibyte format message" and "packaging the information reflecting the actual length in characters of the multibyte format message with the multibyte format message," as further recited in claim 17.

The Examiner correctly notes that *Yergeau* does not specifically disclose packaging the actual length of the multibyte format message with the multibyte format message" (Final Office Action at page 5). However, the Examiner relies on *Berners-Lee* to teach this limitation.

Berners-Lee does not cure the deficiencies of *Yergeau*. *Berners-Lee* discloses that an "entity body is included with a request only when the request method calls for one" (page 29, section 7.2). In addition, "HTTP/1.0 requests containing an entity body must include a valid Content-Length header field" (page 29, section 7.2). *Berners-Lee* discloses that the length of the body is determined by the length in bytes that represents the length of the Entity-Body or by the closing of the connection by the server" (page 30, section 7.2.2).

Berners-Lee discloses determining the number of bytes in such a message. These length determinations do not indicate the correct determination of the actual length in characters of the multibyte format message in all instances.

Such standard functions, like the function in *Berners-Lee*, assume that the data string length is equal to the message length. *Berners-Lee* simply counts the number of bytes, and that value indicates the Content-Length. However, with variable length encoded strings, the number of bytes is often different than the message length. If non-ASCII characters are used, they may require two or more bytes. *Berners-Lee* does not account for this. For example, using the method in *Berners-Lee*, a data string length of 10 bytes would result a content length of 10 characters. However, if non-ASCII characters are used, there may be a actual content length of only 3 or 4 characters. However, the content length in *Berners-Lee* will return a length of 10 regardless of the type of characters contained in the data string. Therefore, *Berners-Lee* does not teach "obtaining an actual length in characters of the multibyte format message" and "packaging the information reflecting the actual length in characters of the multibyte format message with the multibyte format message," as further recited in claim 17.

Accordingly, *Yergeau* and *Berners-Lee* fail to establish a *prima facie* case of obviousness with respect to claim 17, at least because the references fail to teach each and every element of the claim. Claim 18 depends from claim 17 and is thus also allowable for at least the same reasons as claim 17.

Independent claims 20, 23, and 26, though of different scope from claim 17, recite limitations similar to those set forth above with respect to claim 17. Claims 20, 23, and 26 are therefore allowable for at least the reasons presented above. Claims 21,

24, and 27 are also allowable at least due to their dependence from claims 20, 23, and 26 respectively.

II. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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